

REMARKS

Claims 1-19 are pending in the application. Claims 1, 9, 17 and 19 are the independent claims.

The Claims Patentably Define the Invention Over Hitchcock

The Office rejected claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Hitchcock (U.S. Patent Application Publication No. 2005/0080756 A1). Applicant respectfully traverses this rejection and submits that each pending claim is patentable over the cited art.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the Office bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. To establish a prima facie case of obviousness, the Office must show that three basic criteria are met. M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when so modified or combined, must teach or suggest all of the claim limitations. *Id.*

Applicant respectfully submits that the Office has not established a prima facie case of obviousness for at least the following reasons.

Hitchcock Neither Teaches nor Suggests Invalidating Output Modules

Independent claim 9 recites, in part, "invalidating . . . output modules". Independent claim 1 includes a similar recitation. Independent claim 17 recites, in part, "determining whether a[n] output module . . . has been marked as invalid". No aspect of Hitchcock, taken alone or in combination, teaches or suggests invalidation of output modules as claimed.

The Office concedes that Hitchcock fails to expressly state that an output module is invalidated. Office action, p. 4, lns 13-14 and p. 9, lns 14-15. However, the Office instead contends that it would have been obvious that Hitchcock "would entail invalidating other related forms containing incorrect data" due to Hitchcock's "ability to 'share' data among common application elements". Office action, p. 4, ln 20 – p. 5, ln 6 and p. 9, ln 21 – p. 10, ln 7.

Applicant respectfully traverses the Office's obviousness contention for at least the following reasons.

Foremost, the Office has issued an improper § 103 rejection by contending that it is obvious that a reference discloses a particular feature. A reference either discloses - or fails to disclose - a particular feature; submitting that the existence of a feature in a reference is obvious is not proper under § 103.

If the Office is impliedly taking official notice of a teaching or suggestion of invalidating output modules, then Applicant respectfully traverses this implied taking and officially requests that the Office provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Further, the Office's contention as to the obviousness of invalidating other related *forms* is not relevant as applied to the above-identified claim language, which recites invalidation of *output modules*. Nonetheless, Hitchcock explicitly teaches *against* invalidating output modules by stating that "[t]he applicant database can be extended to include new attributes *without making any changes to the forms engine program*". Hitchcock, para. 0065, lns 1-3 (emphasis added).

Accordingly, Applicant respectfully submits that the Office does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least these reasons, independent claims 1, 9 and 17, along with their respective dependent claims (2-8 and 10-16), are not rendered obvious under 35 U.S.C. § 103(a).

Hitchcock Neither Teaches nor Suggests Regenerating Invalidated Output Modules

Independent claim 9 recites, in part, "regenerating the requested output module if the requested output module has been invalidated". Independent claim 1 includes a similar recitation. Independent claim 17 recites, in part, "determining whether a[n] output module . . . has been marked as invalid [and] if so: regenerating the output module". No aspect of

Hitchcock, taken alone or in combination, teaches or suggests regeneration of invalidated output modules as claimed.

The Office cites to para. 65 of Hitchcock for disclosing the above-identified claim language (Office action, p. 4, ln 8 and p. 9, ln 4), but the cited section explicitly teaches *against* regenerating output modules by stating that “[t]he applicant database can be extended to include new attributes *without making any changes to the forms engine program*”. Hitchcock, para. 0065, lns 1-3 (emphasis added).

If the Office is impliedly taking official notice of a teaching or suggestion of regeneration of invalidated output modules, then Applicant respectfully traverses this implied taking and officially requests that the Office provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Accordingly, Applicant respectfully submits that the Office does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least these reasons, independent claims 1, 9 and 17, along with their respective dependent claims (2-8 and 10-16), are not rendered obvious under 35 U.S.C. § 103(a).

Hitchcock Neither Teaches nor Suggests Marking Forms As Invalid

Independent claim 19 recites, in part, “marking each of the identified forms in the form library as invalid”. No aspect of Hitchcock, taken alone or in combination, teaches or suggests marking forms as invalid as claimed.

The Office concedes that Hitchcock fails to expressly state marking forms as invalid. Office action, p. 11, lns 7-8. However, the Office instead contends that it would have been obvious that Hitchcock “would entail invalidating other related forms containing incorrect data” due to Hitchcock’s “ability to ‘share’ data among common application elements.” Office action, p. 11, lns 16-18. Applicant respectfully traverses the Office’s obviousness contention for at least the following reasons.

Foremost, the Office has issued an improper § 103 rejection by contending that it is obvious that a reference discloses a particular feature. A reference either discloses - or fails to disclose - a particular feature; submitting that the existence of a feature in a reference is obvious is not proper under § 103.

If the Office is impliedly taking official notice of a teaching or suggestion of marking forms as invalid, then Applicant respectfully traverses this implied taking and officially requests that the Office provide documentary evidence of this teaching or suggestion in the next action if this rejection is to be maintained. M.P.E.P. § 2144.03.

Further, the sections of Hitchcock cited to by the Office in connection with this obviousness contention (Hitchcock, paras. 3-6 and 65) pertain to simplifying the processing of college admission application forms and customizing the format of a form without making changes to a forms engine program, not marking forms as invalid as claimed.

Accordingly, Applicant respectfully submits that the Office does not establish a prima facie case of obviousness because the prior art, however modified or combined, fails to teach or suggest all the claim limitations. For at least these reasons, independent claim 19 is not rendered obvious under 35 U.S.C. § 103(a).

CONCLUSION


It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Kenyon & Kenyon LLP's Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

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